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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,851	02/25/2002	David Lin	JCLA4539-CA	6981

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EXAMINER

MAYES, MELVIN C

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 04/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,851

Applicant(s)

LIN ET AL.

Examiner

Melvin Curtis Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 18-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

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DETAILED ACTION

Claim Objections

(1)

Claims 8, 10, 20 and 24 are objected to because of the following informalities: Claims 8 and 20 should read “following” instead of “followings,” Claim 10 should read “impression step” instead of “impressing step” and Claims 10 and 24 should read “top of the film...” Appropriate correction is required.

Claim Rejections - 35 USC § 112

(2)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(3)

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing grain projections on the whole surface of the impresser when using a template, does not reasonably provide enablement for “the grain projection are formed on the impresser in a location corresponding to the region of the film” when using a template. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

According to the specification, when using a template to form protuberant structures on a region of a film, the impresser has grain projection over its entire surface (pg. 12, lines 8-22).

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The specification is not enabling for grain projection formed on the impresser in a location corresponding to the region when using a template. Claim 14 should be canceled.

(4)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(5)

Claims 8, 13, 14 and 18-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 20 claim a group including "metal" but then claims complex film can also be composed of "metal." This is not clear. Does Applicant mean that the complex film can be composed of "metals" as according to the specification which states that the material of the film can be "meat foil" while the complex film can be "different metal foils" (pg. 7, lines 8-10).

Claim 13 claims "providing a film" and "the template being placed between the impresser and the transfer..." Where is the film in relation to the template? According to the specification, the film is placed between the template and the impresser. It should be made clear the relationship between the transfer, template, film and impresser. Claim 13 could read "the template being placed between the impresser and the transfer and between the transfer and the film and having..."

Claim 22 claims "providing a buffer layer between the film and transfer." Where is the buffer layer in relation to the template which is placed between the impresser and transfer?

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According to the specification, the buffer layer is between the template and the film. Claim 22 could read “further providing a buffer layer between the template and the film.”

Claim 24 claims “further including the step of placing a protection layer on top of film...” When is this step performed in relation to the “providing a film” and “selecting a region of the film and performing an impression step” of Claim 13. Claim 24 could read “after the impression step is performed, further including...” as claimed in Claim 10.

Claim Rejections - 35 USC § 103

(6)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(7)

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagawa et al. 5,648,107.

Kagawa et al. '107 discloses a method of making a porous film comprising: providing a polymer film; providing a perforating unit of a first block having a surface on which a particles of diamond are deposited and a second block having a surface on which a desired protruding pattern is formed and having a polymer sheet arranged to cover the pattern in the second block; and placing the film between the first and second blocks to press the particles of the first block into the film in the region of the pattern on the second block to perforate the film with a plurality of non-through pores. The first block has diamond particles electro-deposited at a density of about 53,000 particles/cm² which forms non-through pores at the same density of about 53,000 pores/cm². The polymer sheet functions to reduce strains during the pressurization (col. 3, line 45 - col. 7, line 67). Kagawa et al. '107 further discloses that after forming the plurality of non-through pores in a film, the film is laminated on a heat-fusible resin film to obtain a packaging material (col. 9, lines 14-29).

By providing a polymer sheet between the polymer film and the second block, of a perforating unit of first block and second block, to reduce strains during pressurization, a "buffer layer" of plastic is obviously provided between the film and a transfer of a squeezer including an impresser and the transfer.

By providing the first block with diamond particles deposited at a density of about 53,000 particles/cm² and pressing to form non-through pores at the same density of about 53,000 pores/cm², as disclosed by Kagawa et al., a plurality of grain projections (diamond particles) are obviously formed on an impresser (the first block) in a predetermined pattern (density of about

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53,000 particles/cm²) so as to form protuberant structures on the film in an area corresponding to the predetermined pattern, as claimed, because the predetermined density (predetermined pattern) of diamond particles on the first block results in protuberances (protuberant structures) between the non-through pores of same density as that of the particles on the first block (impresser), the protuberances being formed on the film in an area of the film corresponding to the predetermined density (predetermined pattern).

Allowable Subject Matter

(8)

Claims 13 and 18-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

(9)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(10)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 703-308-1977. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
April 1, 2003